



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/655,189	09/04/2003	Carmen R. Porco	374827.13537	6850

7590 01/06/2006
Marvin H. Kleinberg
KLEINBERG & LERNER
2049 Century Park East, #1080
Los Angeles, CA 90067

EXAMINER

MACARTHUR, VICTOR L

ART UNIT	PAPER NUMBER
----------	--------------

3679

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/655,189	Applicant(s) PORCO, CARMEN R.	
	Examiner Victor MacArthur	Art Unit 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 6-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

The reply filed on 10/27/2005 fails to include a record of the substance of the 10/12/2005 phone interview. For purposes of this Office Action only, the examiner assumes the applicants record to be in accordance with the examiners Interview Summary mailed 10/18/2005. Any reply to this Office Action must include a record of the substance of the 10/12/2005 interview in order to avoid a holding of Non-Responsiveness.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 7 and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the lines 1-4 of the preamble of claim 7, it appears that the applicant does not intend to positively claim, "for use with clamping members providing a stable and secure mounting platform for an accessory device... for releasable mounting the accessory device to the clamping members". Accordingly, the "clamping members", "mounting platform" and "accessory device" are taken to be elements merely intended to be used with the "apparatus". For purposes of examination, the examiner has considered claim 7 without combination.

In view of the above, the positive recitations of "the clamping members" (line 6 of claim 7) and "the one clamping member" (lines 16-17 of claim 7) render the claims unclear (i.e., are

Art Unit: 3679

the clamping members being claimed or not?) and should be amended to conform to the intended use set forth in the preamble (e.g., by using language such as --adapted for--, --intended for--, etc.)

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3 and 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Linse (U.S. Patent 5,862,635).

Claim 3. Linse discloses (figs. 1, 2 and 6) an apparatus for mounting an accessory device comprising:

- an outer jaw clamping member (43);
- an inner jaw clamping member (47, 64) adapted to cooperate with said outer jaw clamping member to provide a stable and secure mounting platform for the accessory device (90), said inner clamping jaw member having a central orifice (orifice in 64 receiving 62);
- a coupling member (51, 62) adapted to be connected to the accessory device, said coupling member having a collar portion (62) extending therefrom and adapted to fit into said inner jaw clamping member central orifice;

- and first locking means (67) for securing said collar portion to said inner jaw clamping member, the first locking means including a plurality of first apertures (apertures in 62 receiving 67) around the circumference of said collar member; a diametrically aligned second aperture (aperture in 64 receiving 67) in said inner clamping jaw member; and a pin member (67 as described in col.5, l.20) adapted to be inserted through said second aperture and a selected pair of first apertures for fixedly engaging said coupling member in said inner clamping jaw member in a desired orientation;
- a second locking means including a threaded surface (threads on 51) on said collar portion and a locking nut (54) mounted on said threaded portion for exerting a withdrawing force on said coupling member (i.e., when vise grips are used to apply an upward withdrawing force on element 54).

Claim 6. Linse discloses (figs. 1, 2 and 6) an apparatus for mounting an accessory device to a railing structure comprising:

- an outer jaw clamping member (43);
- an inner jaw clamping member (47, 64) adapted to cooperate with said outer jaw clamping member for attaching to the railing structure to provide a stable and secure mounting platform for the accessory device (90) said inner clamping jaw member having a central orifice (orifice in 64 receiving 62) with an axis substantially orthogonal to the railing structure (as seen in fig.6);

- a coupling member (51, 62) adapted to be connected to the accessory device, said coupling member having a collar portion (62) extending therefrom and adapted to fit into said inner jaw clamping member central orifice;
- first locking means (67) for securing said collar portion to said inner jaw clamping member, including a plurality of first apertures (apertures in 62 receiving 67) around the circumference of said collar member; a diametrically aligned second aperture (aperture in 64 receiving 67) in said inner clamping jaw member; and a pin member (67) adapted to be inserted through said second aperture and a selected pair of first apertures for fixedly engaging said coupling member in said inner clamping jaw member in a desired orientation relative to the railing structure
- a second locking means (54, 51) including a threaded portion (threaded portion of 51) on said collar portion and a locking nut (54) mounted on said threaded portion for exerting a withdrawing force on said coupling member (i.e., when vise grips are used to apply an upward withdrawing force on element 54).

Claim 7. Linse discloses (figs. 1, 2 and 6) an apparatus comprising:

- a central orifice (orifice in 64 receiving 62) having a diametrically aligned first aperture (aperture in 64 receiving 67);
- a coupling device (47, 51, 62) having a collar member (51, 62) extending therefrom and sized to fit into the central orifice;
- locking means (63, 67) for securing the collar member to the one clamping member including a plurality of second apertures (63) around the circumference of the collar

Art Unit: 3679

member and a pin member (67) sized to be inserted through the first aperture and a selected pair of second apertures for fixedly engaging the collar member in the orifice in a desired orientation.

- The Linse apparatus is fully capable of performing the applicant's intended use limitations as recited in the preamble.

Claim 8. Linse discloses the apparatus of claim 7, further including:

- second locking means (51) including a threaded surface (51) on the collar member and a locking nut (54) mounted on the threaded surface for exerting a withdrawing force on the pin member (i.e. when vise grips are used to apply an upward withdrawing force on element 54).

Allowable Subject Matter

As noted in the previous Office Action and repeated herein, claims 3 and 6 as currently written do not necessarily require that the collar itself be threaded. Rather the claims are currently broad enough to allow for a threaded surface on an element that is distinct from but mounted or connected "on said collar portion".

Claims 3 and 6 would be allowable if rewritten to replace the limitation "a threaded surface on said collar portion" (lines 22 of claim 3 and lines 24-25 of claim 6) with --a threaded outer collar surface of said collar portion--.

Response to Arguments

Applicant's arguments with regard to the claim rejections have been fully considered but they are not persuasive.

The applicant argues that claims 3 and 6 have been amended to incorporate the allowable subject matter noted by the examiner in the previous Office Action and are therefore allowable. This is not persuasive since the applicant has not amended to incorporate the suggested allowable terminology --a threaded outer collar surface of said collar portion--.

The applicant argues that claims 7 and 8 should be allowed since they are similar to claims 3 and 6. This is not persuasive. The examiner notes that the scope of new claims 7 and 8 is much broader (e.g. intended use recitation of "clamping members") than that of claims 3 and 6. Accordingly, statements regarding the allowability of claims 3 and 6 do not apply to claims 7 and 8 unless specifically stated otherwise.

Conclusion

Applicant's amendment (i.e., the newly added intended use preamble of claim 7) necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

Art Unit: 3679

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor MacArthur whose telephone number is (571) 272-7085. The examiner can normally be reached on 8:30am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-3600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

VLM

VLM

January 3, 2006



DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600